



#171508B  
4126102  
PATENT  
Attorney Docket No. SALK1510-3  
(088802-8704)  
Bx 8y

CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"

Date of Deposit: April 10, 2002

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Stephen E. Reiter

Printed Name

Stephen E. Reiter  
Signature

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Evans et al.

Serial No.: 09/522,753

Filing Date: March 10, 2000

For: FAMILY OF TRANSCRIPTIONAL CO-  
REPRESSORS THAT INTERACT WITH  
NUCLEAR HORMONE RECEPTORS AND  
USES THEREFOR

Examiner: B. Loeb

Group Art Unit: 1636

TRANSMITTAL

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Arlington, VA 22202

Dear Sir:

Enclosed please find the following:

- [X] Statement to Support Filing and Submission in Accordance with 37 C.F.R. §§ 1.821-1.825
- [X] Copy of 1<sup>st</sup> 4 pages of Office Action dated 10/10/01 requesting Sequence Compliance (on page 3)
- [X] Copy of Petition for Extension of Time filed under separate cover with the response to the Office Action, requesting 3 month extension of time.

|  |   |
|--|---|
| In re Application of<br>Evans et al.<br>Application No. 09/522,753<br>Page 2 | PATENT<br>Attorney Docket No. SALK1510-3<br>(088802-8704) |
|--|---|

- ☒ Computer Disk Containing Sequence Listing
- ☒ Sequence Listing Paper Copy
- ☒ Return postcard

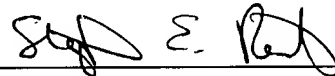
No fee is deemed necessary in connection with this paper. However, if any fee is required, the Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17, and 1.21 that may be required by this transmittal, or to credit any overpayment, to Deposit Account No. 50-0872.

Respectfully submitted,

Date: April 10, 2002

FOLEY & LARDNER  
P.O. Box 80278  
San Diego, California 92138-0278  
Telephone: (858) 847-6711  
Facsimile: (858) 792-6773

By



Stephen E. Reiter  
Attorney for Applicant  
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|                 |             |                      |                     |
|-----------------|-------------|----------------------|---------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|

09/522,753 03/10/00 EVANS

R SALK1510-3

STEPHEN E REITER  
FOLEY AND LARDNER  
402 WEST BROADWAY  
23RD FLOOR  
SAN DIEGO CA 92101-3510

HM22/1010

EXAMINER

LOEB, B

ART UNIT

PAPER NUMBER

1636

DATE MAILED:

10/10/01

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OCT 15 2001

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I.P. DEPT.  
FOLEY & LARDNER

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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|                      |                 |
|----------------------|-----------------|
| DOCKETING DEPARTMENT |                 |
| Due:                 | 1/10/02         |
| Drop Date (DD):      | 4/10/02         |
| 1st Reminder:        | 12/10/01        |
| Initials:            | SWB MDC Entered |

088802/8704

2 - Mail Copy

## Office Action Summary



Application No.

82/522,753

Examiner

Bronwen M. Loeb

Applicant(s)

EVANS ET AL.

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 23.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 26-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: \_\_\_\_\_

Art Unit: 1636



### DETAILED ACTION

This action is in response to the communications filed 2 August 2001.

Claims 1-37 are pending.

### *Election/Restrictions*

1. Applicant's election with traverse of Group I in Paper No. 8 is acknowledged.

The traversal is on the ground(s) that the claims are interrelated and a prior art search of one group would involve a search of the other groups. This is not found persuasive because while different inventions may be interrelated, this certainly does not dictate that the searches of the different inventions are interrelated or coextensive. For instance, one can search a polypeptide and it can be found in the art as a result of its function and in the absence of the polynucleotide sequence encoding it. Similarly, a search for an antibody may well encompass only the polypeptide to which it binds and not the polynucleotide sequence encoding the polypeptide.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 26-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.
3. Claims 8-13 and 17 were withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. There was no art found on the elected species, however, so these claims have been examined.

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***Sequence Compliance***

4. The Office has corrected minor errors in the computer readable format of the sequence listing. Specifically, the asterisks in the sequence data (e.g. SEQ ID No. 6) have been removed. Applicant does not need to take any action with respect to this information.
5. SEQ ID No. 3 is listed as a 17 nucleotide sequence on p. 38, lines 16-17, in the paper listing and the CRF, however, on p. 66, line 19 of the specification, it is listed as a sequence of nine amino acids.
6. On p. 66, lines 5, 13, 14, 18, 2 and 25, there are references to amino acids 1698-2063 and 2929-3038 of SEQ ID No. 1, however SEQ ID No. 1 in the paper listing has only 1495 amino acids.
7. Figures 2, 5, 6, 9 and 12 have unidentified sequences in them. It is often convenient to identify sequences in figures by amending the Brief Description of the Drawings section (see MPEP § 2422.02).

Applicants are required to comply with all of the requirements of 37 CFR 1.821 through 1.825. Any response to this office action that fails to meet all of these requirements will be considered non-responsive. The nature of the noncompliance with the requirements of 37 C.F.R. 1.821 through 1.825 did not preclude the continued examination of the application on the merits, the results of which are communicated below.



Atty. Dkt. No SALK1510-3  
(088802-8704)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Evans et al.

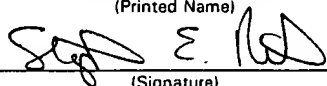
Title: FAMILY OF TRANSCRIPTIONAL CO-  
REPRESSORS THAT INTERACT WITH  
NUCLEAR HORMONE RECEPTORS  
AND USES THEREFOR

Appl. No.: 09/522,753

Filing Date: 03/10/2000

Examiner: B. Loeb

Art Unit: 1636

|   |  |
|---|--|
| <b>CERTIFICATE OF FACSIMILE TRANSMISSION</b>  |  |
| I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Washington, D.C. on the date below. |  |
| <u>Stephen E. Reiter</u>  |  |
| (Printed Name)  |  |
| <u></u>   |  |
| (Signature)   |  |
| <u>April 10, 2002</u>   |  |
| (Date of Deposit)   |  |

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PETITION FOR EXTENSION OF TIME

Commissioner for Patents  
Washington, D.C. 20231

Sir:

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Applicant hereby petitions the Commissioner under 37 C.F.R. §1.136(a) for a three-month extension of time for response in the above-identified application for the period required to make the attached response timely.

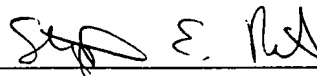
The extension fee for response within the third month is \$460.00.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872.

Respectfully submitted,

Date: April 10, 2002

By



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